

upon claim 13. Therefore, it is respectfully suggested that the rejection of claim 5 is improper and should be withdrawn.

The M.P.E.P. sets forth the criteria for a rejection for obviousness as follows:

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure.

See, MPEP § 706.02(j) citing In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

It is respectfully suggested that the combination of Borman, Luibrand, Bullard et al., and Harper fails to teach or suggest each feature of claim 1. Specifically, claim 1 recites a filter for filtering hydraulic fluid pumped to an automatic transmission and to a steering gear. In rejecting claim 1, the Examiner relies upon Harper for the teachings relating to the filter. However, Harper fails to teach or suggest that a filter for filtering hydraulic fluid that is pumped to a steering gear.

Harper discloses an auxiliary pressurization device 50 that operates independently of an internal hydraulic pump 22 of an automatic transmission for supplying hydraulic fluid to the automatic transmission when the internal pump 22 is not

operating. (Harper, Col. 4, lines 14-21). The auxiliary pressure device 50 includes a pump 66 that draws hydraulic fluid from a reservoir 30 and provides the hydraulic fluid to the automatic transmission. A filter 48 for filtering the fluid is provided in the fluid line 40 leading to the pump 66. (Harper, Col. 4, lines 1-6).

Thus, at most, Harper teaches providing a filter for filtering hydraulic fluid pumped to an automatic transmission. Harper fails to teach or suggest filtering hydraulic fluid supplied to a power steering gear. Borman, Luibrand, and Bullard et al. fail to make up for the deficient teachings of Harper, as none of the references teaches or suggests filtering hydraulic fluid that is supplied to a power steering gear. Since none of Borman, Luibrand, Bullard et al., and Harper teaches or suggests filtering hydraulic fluid that is supplied to a power steering gear, a combination of the references also fails to teach or suggest this feature. Therefore, it is respectfully suggested that the rejection of claim 1 is improper and should be withdrawn. Allowance of claim 1 is respectfully requested.

Furthermore, one of ordinary skill in the art, given the teachings of Harper, would not be motivated to use the pump 66 to draw hydraulic fluid from the reservoir 30, through filter 48, and supply the fluid to a power steering gear. The pump 66 of Harper forms part of an auxiliary pressurization device 50 and is only for supplying hydraulic fluid to an automatic transmission when the internal pump 22, i.e., the primary fluid pump for the automatic transmission, is not operating. Since

pump 66 forms part of an auxiliary pressurization device 50, Harper teaches that the device 50 should not reduce the operating efficiency of the vehicle and therefore, provides an auxiliary power source for operating the device 50. (Harper, Col. 8, lines 6-12). Thus, one of ordinary skill in the art, given the teachings of Harper, would not be motivated to run pump 66 continually, which would likely require use of the vehicles main power source (i.e., reducing operating efficiency of the vehicle), for supplying hydraulic fluid to the steering gear. Thus, for this further reason, it is respectfully suggested that the rejection of claim 1 is improper and should be withdrawn. Allowance of claim 1 is respectfully requested.

It is respectfully suggested that the combination of Borman, Luibrand, Bullard et al., and Harper only seems plausible using hindsight after having the benefit of the Applicants' disclosure. The use of the teachings of the present invention to find obviousness is impermissible.

The court must be ever alert not to read obviousness into an invention on the basis of applicant's own statements; that is, we must view the prior art without reading into that art applicant's teachings. The issue, then, is whether the teachings of the prior art would, in and of themselves and without the benefits of appellant's disclosure, make the invention as a whole obvious.

In Re Sponnoble, 160 USPQ 237 at 243 (CCPA 1969) (emphasis in original). Accordingly, the Examiner must consider only the teachings of the prior art references. Without the teachings of the present invention, one of ordinary skill in the art

would not even consider combining the teachings of Borman, Luibrand, Bullard et al., and Harper to attempt to arrive at the presently claimed invention.

It is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has previously stated that '[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.'

In Re Fritch, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992). Thus, for this still further reason, allowance of claim 1 is respectfully requested.

Claims 2 and 3 depend from claim 1 and are allowable for at least the same reasons as claim 1. Additionally, claims 2 and 3 are allowable for the specific limitations of each claim.

Specifically, claim 2 recites that the at least one pump comprises a transmission fluid pump and a power steering pump that is separate from the transmission fluid pump. Thus, claim 2 further distinguished from the teachings of Harper in that a separate pump provides fluid to the power steering gear. One of ordinary skill in the art would not be motivated to use a separate power steering pump to draw fluid through filter 48 of Harper, which is also in fluid communication with pump 66 for pumping fluid to the automatic transmission, and then supply the fluid to the power steering gear. One of ordinary skill in the art would recognize that using two separate pumps to draw fluid through a single filter might

cause problems, such as back flow through one of the pumps. Thus, allowance of claim 2 is respectfully requested.

Claim 8 recites a method that includes the step of filtering the hydraulic fluid pumped between the reservoir and the automatic transmission and the hydraulic fluid pumped between the reservoir and the fluid motor of the power steering gear. For reasons similar to those set forth with regard to claim 1, it is respectfully suggested that a combination of Borman, Luibrand, Bullard et al., and Harper fails to teach or suggest filtering the hydraulic fluid pumped between the reservoir and the fluid motor of the power steering gear. Since Borman, Luibrand, Bullard et al., and Harper fail to teach or suggest this feature of claim 8, it is respectfully suggested that the rejection of claim 8 is improper and should be withdrawn. Allowance of claim 8 is respectfully requested.

Claims 9-11 depend from claim 8 and are allowable for at least the same reasons as claim 8. Additionally, claims 9-11 are allowable for the specific limitation of each claim.

Specifically, claim 9 recites operating a transmission fluid pump and operating a power steering pump that is separate from the transmission fluid pump. For reasons similar to those set forth with regard to claim 2, allowance of claim 9 is respectfully requested.

Claim 12 was rejected as obvious under 35 U.S.C. §103 over Borman, Luibrand, Bullard et al., Few et al., and Harper. This rejection of claim 12 is respectfully traversed.

Claim 12 recites a filter for filtering hydraulic fluid. The filter is located in a fluid flow path of the hydraulic fluid for operating the automatic transmission and also is located in a fluid flow path of the hydraulic fluid for operating the steering gear. It is respectfully suggested that a combination of Borman, Luibrand, Bullard et al., Few et al., and Harper fails to teach or suggest this feature of claim 12. Specifically, Harper, which the Examiner relies upon for the teachings relating to the filter, fails to teach or suggest that the filter is located in a fluid flow path of hydraulic fluid for operating the steering gear. Harper discloses filter 48 being located in a closed fluid circuit that leads only to the automatic transmission. (Harper, Fig. 2). Since Borman, Luibrand, Bullard et al., Few et al., and Harper fail to teach or suggest this feature of claim 12, it is respectfully suggested that the rejection of claim 12 is improper and should be withdrawn. Allowance of claim 12 is respectfully requested.

Claim 13 was rejected as obvious under 35 U.S.C. §103 over Borman in view of Luibrand, Bullard et al., and Few et al. The rejection of claim 13 is respectfully traversed.

Claim 13 recites at least one pump connected with the reservoir for pumping hydraulic fluid between the reservoir and the automatic transmission and the fluid motor. A combination of Borman, Luibrand, Bullard et al., and Few et al. fails to teach or suggest this feature of claim 13. None of Borman, Luibrand, Bullard et al., and Few et al. teaches or suggests two separate pumps for pumping hydraulic fluid from a

single reservoir. Therefore, there is no suggestion or motivation to modify Borman to include a steering gear pump from Luibrand and also a separate automatic transmission pump from Bullard et al. Borman teaches a single pump 42 in fluid communication with reservoir 10 for supplying hydraulic fluid to the fluid system 46. (Borman, Col. 2, lines 28-44). Since none of Borman, Luibrand, Bullard et al., and Few et al. teaches or suggests two pumps associated with a single reservoir, a combination of the references also fails to teach or suggest this feature. Therefore, it is respectfully suggested that the rejection of claim 13 is improper and should be withdrawn.

Moreover, claim 13 recites that the at least one pump comprises a transmission fluid pump connected with the reservoir for pumping hydraulic fluid between the reservoir and the automatic transmission at a relatively low pressure, and a power steering pump connected with the reservoir and separate from the transmission fluid pump for pumping hydraulic fluid between the reservoir and the fluid motor at a relatively high pressure. In rejecting claim 13, the Examiner states that Few et al. implies that 50 p.s.i. is excessive pressure for an automatic transmission. However, this statement improperly characterizes the teaching of Few et al. in Col. 1, lines 43-58). Few et al. teaches that in a particular prior art device for replacing used transmission fluid with new transmission fluid in which fluid pressure of the used transmission fluid moves a piston to force the new transmission fluid into the fluid reservoir, 50 p.s.i. is

excessive pressure for the used transmission fluid. Thus, this teaching in Few et al. has nothing to do with the operating pressure of an automatic transmission, but only deals with used transmission fluid pressure in a fluid replacement device. Thus, the rejection of claim 13 improperly uses this teaching of Few et al. to imply that an automatic transmission pump will be at low pressure.

Furthermore, in rejecting claim 13, the Examiner using a teaching of at least 40 p.s.i. for a teaching of high pressure for a steering pump motor and a teaching that 50 p.s.i. is excessive for teaching for a low pressure automatic transmission pump. However, the cited pressures fail to show one pump operating at a high pressure and one at a low pressure. Given the teachings cited by the Examiner, if both a power steering pump and an automatic transmission pump operate at 42 p.s.i., the criteria of the cited prior art are met. However, the feature of claim 13 of a transmission fluid pump for pumping hydraulic fluid at a relatively low pressure and a power steering pump for pumping hydraulic fluid at a relatively high pressure is not met. Therefore, for this further reason, allowance of claim 13 is respectfully requested.

Claims 5 and 6 depend from claim 13 and are allowable for at least the same reasons as claim 12.

Claim 14 was rejected as obvious over Borman in view of Luibrand, Bullard et al., and Hayabuchi et al., U.S. Patent No. 5,547,436. This rejection is respectfully traversed.

Claim 14 recites at least one pump comprising a single pump operative to output fluid at a pressure high enough to operate the power steering gear. A first output line directs hydraulic fluid at a relatively high pressure from the single pump to the steering gear. A second output line directs hydraulic fluid at a relatively high pressure from the single pump to a pressure reducer and a third output line directs hydraulic fluid at a relatively low pressure from the pressure reducer to the automatic transmission. None of Borman, Luibrand, Bullard et al., and Hayabuchi et al. teaches or suggests a pressure reducer that receives hydraulic fluid at a pressure high enough to operate a power steering gear and reduces the pressure for operating an automatic transmission. Since none of Borman, Luibrand, Bullard et al., and Hayabuchi et al. teaches or suggests this feature of claim 14, a combination of Borman, Luibrand, Bullard et al., and Hayabuchi et al. also fails to teach or suggest this feature. Therefore, it is respectfully suggested that the rejection of claim 14 is improper and should be withdrawn. Allowance of claim 14 is respectfully requested.

In view of the foregoing, it is respectfully submitted that the above-identified patent application is in condition for allowance, and allowance of the above-identified patent application is respectfully requested.